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EXAMINER

LEE, CHEUKFAN

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,776

Applicant(s)

FREDLUND ET AL.

Examiner

Cheukfan Lee

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 16, 2006, December 19 and 5, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, and 14-28 renumbered as claims 29-43, respectively is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 is/are allowed.
- 6) ☒ Claim(s) 29 and 31-43 is/are rejected.
- 7) ☒ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2627

1. The second terminal disclaimer filed March 13, 2006 has been approved.

In the conversation with Applicant on March 9, 2006, Applicant was informed that the first terminal disclaimer filed December 19, 2005 was not approved due to the fact that Attorney Thomas J. Strouse was not an attorney of record. The Power of Attorney and the second terminal disclaimer filed March 13, 2006 were the result of that conversation.

2. Claims 14-28 presented in the amendment/response file December 19, 2005 have been renumbered by the examiner as new claims 29-43, respectively, in accordance with 37 CFR 1.126, and are treated as new claims.

Claims 14-28 have been canceled in the amendment/response filed December 5, 2005. These claims were inadvertently canceled, according to the response/amendment filed December 19, 2006. These claims cannot be just added back using the same claim numbers. The canceled claims 14-28 should stay canceled in any amendment presented thereafter, and any claim that is added back or presented thereafter should be numbered using the next new claim number, in this case, numeral 29 (for claim 14).

The art rejection addressed below uses the new claim numbers 29-43 for canceled claims 14-28, respectively.

Applicant is advised to present the claims according to their new numbering 29-43 in a next response/amendment.

Art Unit: 2627

3. Claims 1-13 and 29-43, as a result of the renumber the claims from 14-28 to claims 29-43, are pending. Claims 1 and 29 are independent.

4. Applicant traversed the examiner's objection of claims 14-28 addressed in paragraph 4 on page 2 of the Office Action dated October 5, 2005 but have amended the claims as suggested by the examiner. See the remarks, page 6, paragraph 3 filed December 19, 2005. The objection has been reviewed and is concluded appropriate. Applicant's intention of or reason for the traversal is not understood. No response is needed since the claims have been amended as suggested in the Office Action.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 29 and 31-39, corresponding to the old claims 14 and 16-24 before renumbering the claims, are rejected under 35 U.S.C. 102(e) as being anticipated by Yamazaki (Japanese Patent Applicant Publication No. 06-311338), cited by Applicant in the Information Disclosure Statement filed April 14, 2004. A machine-translated English translation of the publication is attached and referred to in the rejection below.

Regarding 29 (old claim 14), Yamazaki discloses an image management system for remotely ordering image products or services by customers with respect to digitally stored images. A film scanner (9) scans a film, and digital image data is generated and stored in a memory (10) (paragraph 0010). The scanner (9) and memory (10) are controlled by controller (11) of the lab, which inherently comprises a computer having the controller (11). The digital image data and an associated number (including print identification code) for identifying the digital file of each customer are stored in the memory (10) of the inherent computer (paragraphs 0017-0019). The customer (the photographer) makes a request to the lab over a telephone line (or the like) using the associated number (print identification number) to order the product or services (paragraphs 0019 and 0021, the abstract). It is inherent that the memory (10) in the lab stores digital files for a plurality of customers as opposed to one customer. The inherent computer in the lab facilitates remote electronic ordering of an image product or a service by each of the customers with respect to the images over a communication network (telephone line or the like in paragraph 0019) using the associated number (print identification number).

Regarding claims 31-34 (old claim 16-19), the electronic ordering is accomplished by entering the order using device for providing electronic communication over the communication network (telephone line or the like, paragraph 0019), which inherently includes the claimed limitations of claims 32-34 (old claims 17-19).

Art Unit: 2627

Regarding claim 35 (old claim 20), the image product comprises a photographic print (paragraph 0021).

Regarding claims 36 and 38 (old claims 21 and 23, respectively), the digital file is obtained by scanning a developed film (paragraphs 0010).

Regarding claim 37 (old claim 22), the electronic ordering inherently comprises ordering by voice (paragraph 0019).

Regarding claim 39 (old claim 24), the image comprises a plurality of images since the film being scanned comprises a plurality of frames of images (Fig. 3).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 40-43, corresponding to old claims 25-28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamazaki (Japanese Patent Applicant Publication No. 06-311338), cited by Applicant in the Information Disclosure Statement filed April 14, 2004. A machine-translated English translation of the publication is attached and referred to in the rejection below.

Art Unit: 2627

Regarding claim 40 (old claim 25), Yamazaki discussed for claim 40 (old claim 25) discloses that the image(s) and an order number (print identification code) are printed on the print (paragraph 0017). Although Yamazaki does not disclose producing index prints, the examiner took Official Notice of the fact that providing an index print to a customer for the purpose of saving printing material is an old and well known idea in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the concept of the well known concept to provide index prints to customers with images an order number (print identification code) printed thereon, in order to save printing material as is known in the art.

Regarding claim 41 (old claim 26), according to the discussion of claim 40 above, the order number (print identification code) identifies the digital file of the index print.

Regarding claim 42 (old claim 27), although not disclosed by Yamazaki, the examiner good Official Notice of the fact that verifying customer information such as the address and credit card number are old and well known feature in the art of ordering a product or service. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the known concept to provide Yamazaki the step of verifying the customer's address and credit card number before granting the product or service to make sure valid payment information and delivery location for the order.

Regarding claim 43 (old claim 28), the location of the scanner (9) and the location of the memory (10) meet the claimed "first location" and "second location", respectively.

9. Claim 30, corresponding to old claim 15, is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is an examiner's statement of reasons for allowance:

The filing of the terminal disclaimer filed March 13, 2006 has overcome the obviousness type double patenting rejection of claims 29-43 (as amended above) under 35 U.S.C. 101.

Claims 1-13 were allowed in the previous Office Action dated December 5, 2005. There is no double patenting of either the same type or the obviousness type between the claims and any of the claims of the patent U.S. Patent No. 6,600,572. Specifically, the limitation recited in claim 1, "facilitating the destination of a party by said customer to which said image product or service is to be provided", is not claimed in any of the claims of the patent.

Claims 1-13 and claim 15 are/would be allowable over the prior art of record because the prior art, including the closest prior art reference Yamazaki (Japanese Patent Application Publication No. 06-311338), cited by Applicant and applied above in the rejection, does not disclose facilitating the destination of a party by the customer to

Art Unit: 2627

which the image product or service is to be provided as claimed in claim 1, or that the product or service is provided to a party designated by one of the customers as claimed in claim 15.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Garfinkle et al. (U.S. Patent No. 6,017,157)

Fredlund et al. (U.S. Patent No. 6,154,295)

Fredlund et al. (U.S. Patent No. 6,353,487)

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (571) 272-7407. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee
March 16, 2006



Cheukfan Lee